

REMARKS

Summary

Claims 1-19 pending and all of the claims were rejected in a final Office action. In response to the final Office action, the Applicants submitted a response which resulted in the present advisory action. In order to clearly present the amendment for the Request for Continuing Examination (RCE), the Applicants have repeated the arguments and the amendments previously made, and respectfully submit that they are adequate to overcome the rejections. However to expedite the prosecution of this application, Claims 1 and 18 have been amended to respond to the Examiner's comments in the final Office action, and additional arguments presented with respect to Claims 1 and 19. Claims 1, 5, 6, 12, 13, 15, 18 and 19 have been amended. No new matter has been introduced. Claims 1-19 are pending after entry of this amendment. The Applicants have carefully considered the reasons advanced by the Examiner and respectfully traverse the rejections in view of the amendments and the discussion presented below.

Claim Rejections

35 U.S.C. § 112, second paragraph

Claims 5 and 6 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out the subject matter which the applicant regards as the invention. In particular, in Claim 5, the recitations of "the ball" and "the pin" are said to lack antecedent basis. In Claim 6, the recitation "the at least two balls and pins is" is said to contradict the recitation in Claim 1 of "at least one of a ball and a pin" The Applicants respectfully traverse these rejections, but have made amendments to Claims 5 and 6 to clarify the relationship of the elements.

With respect to Claim 5, which depends on Claim 1 the Applicants respectfully submit that Claim 1 recites "a ball" and "a pin", which provide appropriate antecedent

basis for the recitation “the at least one of the ball and the pin” in Claim 5. With respect to Claim 6, which is dependent on Claim 1, the recitation of “a ball” and “a pin” is interpreted by the Federal Circuit as meaning one or more. Claim 6 has been amended to positively recite multiple balls and pins.

In view of the clarifying amendments and these remarks, the applicants respectfully request that the rejections be withdrawn.

35 U.S.C. §102 (b)

Claims 1-19 were rejected, under 35 U.S.C. §102 (b) as being anticipated by Levin et al. (US 6,154,201: “Levin”).

The Applicants believe that the arguments presented previously are correct, and they are maintained.

Claim 1 has been amended to clarify the structure of the apparatus, and reads, *inter alia*, a feeling providing device and an actuator which positions at least one of a ball and a pin in contact with the feeling providing device.

In the advisory action, the Examiner asserts that the knob 18 as manipulated by an operator can be considered an actuator. As the reference itself describes an actuator 70, considering the knob 18 (manipulated by the operator) to be an actuator would now identify two different structures as an actuator, and this would be considered to be ambiguous. Since the reference issued as a patent, the Office must have concluded that the knob 18 did not function as an actuator 70. However, the amendment to Claim 1 sets forth the subject matter such that it is clearly differentiated from the Examiner’s interpretation of the reference.

Nevertheless, the Applicants respectfully traverse the Examiner’s statements in item 5 of the advisory action. The detailed grounds are set forth below, when discussing the rebuttal of the final Office action. To reiterate, there is no basis for incorporating an action of a user into the description of an apparatus in order to remedy a lack of an essential element in an apparatus being used as a reference in an anticipation rejection.

Although the Applicants believe that valid reasons also exist for the independent patentability of Claims 2-5 and 8-17, it suffices that they are dependent on Claim 1 and are allowable, without more.

The Applicants respectfully reiterate the traverse of the Examiner's rebuttal as set forth in the final Office action. Moreover, the case law cited below is on point and the Applicants respectfully submit that it directly refutes the position taken by the Examiner. The Examiner asserts that "using the action of the operator in Levin's device does not preclude the use of Levin to reject the claimed invention" (Office action, page 5). But, in *In re Bernhart*, 417 F2d. 1395, 1399, 163 USPQ 611, 615 (CCPA 1969) the court stated:

We know of no authority for holding that a human being, such as a draftsman, could ever be the equivalent of a machine disclosed in a patent application, and we are not prepared to so hold in this case.

That is, a human action such as applying a force, or turning a knob, cannot be substituted for an element or limitation of an apparatus which performs that function. Hence, for Claim 1 to be anticipated, the machine itself in Levin would have to perform the actions required without human intervention, but the Examiner relies on forces and motions of the operator to provide elements and limitations for the rejection of Claim 1.

Further, in view of the Examiner's response, where additional elements of Levin are cited in the final Office action, for example at page 3, lines 4-5, the Applicants re-state and amplify on the traversal made in a previous response.

The Examiner identifies a knob (18) as the actuator (by pushing on the knob 18), whereas Levin identifies two elements, the knob (18) and the actuator (70). (Levin, col. 7 line 57 and col. 9 line 58). Since they are two different elements, it is at best ambiguous for the Examiner to refer to the knob as an actuator in the sense

taught by Levin. Further, the Examiner asserts that the actuator (by [the operator] pushing the knob 18) positions the ball (84) to contact one of the disk or the cylinder.

Element 84, shown in Fig. 4B and 4C as a flat surface on a stamping (85) which is deformed to form the flexible coupling (82), and is not described or drawn by Levin as a ball, nor would in comport with any dictionary definition of a ball. Indeed, Levin does not use the word “ball” at all. So any suggestion that element 82 is a ball must come from a suggestion made in the present application; the Applicants respectfully submit that they have not described the structure taught by Levin. A pin (50) is said to be elastically forced to contact one of the disk and the cylinder. The elements are not identified by number in the citation of the reference. The Applicants can only speculate as to the associations. *Arguendo*, if the pin is (50) and the actuator is the cylinder (70), the pin (50) is not elastically forced into contact with the actuator (70). *Arguendo*, if the actuator is switch (90) and the pin (50) is threaded through the center thereon, it is only possible to bring the pin (50) in contact with the switch (90) by the application of an external force by an operator to the knob (18).

The Examiner identifies element (52) as a disc and element (54) as plural feeling patterns. In contrast, Levin identifies (52) as a switch and (54) as output leads (column 8, lines 32-40, *Id.*). The output leads (54) are fixed to the portion of the switch attached to the front panel (12), rather than the shaft (50) as suggested by the Examiner, and (50) is a shaft rather than a pin. In order for the shaft (50) to contact the portion of the switch (54) that is attached to the front panel (12), the operator must provide the force. The shaft cannot contact the switch (54) or the switch (90) in Levin except in response to a force exerted by the operator.

For at least the reasons given above, Levin does not teach all of the elements of Claim 1, nor the arrangement thereof, a *prima facie* case of anticipation has not been made out, and the claim is allowable.

Claims 5, 6 and 7 are independently patentable, as well as being patentable as claims dependent on allowable Claim 1. The Examiner identifies element 52 as a

disc and element 54 as plural feeling patterns. In contrast, Levin identifies 52 as a switch and 54 as output leads (column 8, lines 32-40, *Id.*). The output leads are 54 are fixed to the portion of the switch attached to the front panel 12, rather than the shaft 50 as suggested by the Examiner, and 50 is a shaft rather than a pin. In order for the shaft 50 to contact the portion of the switch 54 that is attached to the front panel 12, the operator must provide the force. Operator action is not an integral part of the structure, so the shaft cannot contact the switch in Levin except in response to a force exerted by the operator. As such, the Examiner has not made out a *prima facie* case of anticipation, which would require that all of the elements and the arrangement thereof be shown in Levin. Claims 5, 6, and 7 are also allowable as claims dependent on allowable Claim 1.

Claim 18 has been amended to incorporate the same clarification of the subject matter as Claim 1, and is allowable for at least that reason.

Amended Claim 19 recites, *inter alia*, the actuator is controlled according to a control signal generated based on an external signal from an external detector.

As the Examiner asserts that the actuator the movement of the knob by the user (advisory action, continuation sheet), the reference does not teach that the actuator is "controlled according to a control signal", and thus Claim 19 is not anticipated.

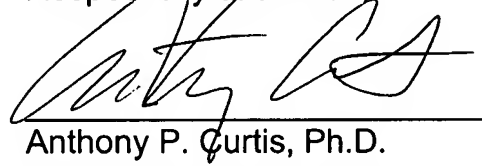
Conclusion

Claims 1- 19 were pending; Claims 5, 6, 12, 13, 15, 18 and 19 have been amended. Claims 1-19 are now pending.

For at least the reasons given above, the Applicants respectfully submit that the pending claims are allowable.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony P. Curtis', is written over a horizontal line.

Anthony P. Curtis, Ph.D.
Registration No. 46,193
Agent for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200